APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,685	03/05/2002	Alfred Thomas	07-2176-A	8496

20306   7590   03/12/2008
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ART UNIT	PAPER NUMBER
3711	

MAIL DATE	DELIVERY MODE
03/12/2008	PAPER

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1   RECORD OF ORAL HEARING

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3   UNITED STATES PATENT AND TRADEMARK OFFICE

4   ——————

5

6   BEFORE THE BOARD OF PATENT APPEALS

7   AND INTERFERENCES

8   ——————

9

10   Ex parte ALFRED THOMAS, DUNCAN F. BROWN,

11   LAWRENCE E. DEMAR and SCOTT D. SLOMIANY

12   ——————

13

14   Appeal 2007-2444

15   Application 10/090,685

16   Technology Center 3700

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20   Oral Hearing Held: February 20, 2008

21   ——————

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24 Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.

25 FISCHETTI, Administrative Patent Judges

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27 ON BEHALF OF THE APPELLANT:

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36 The above-entitled matter came on for hearing on Wednesday, February 20,

37 2008, at The U.S. Patent and Trademark Office, 600 Dulany Street,

38 Alexandria, Virginia, before Virginia Johnson, Freestate Reporting, Inc.

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2   P R O C E E D I N G S

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4   MS. HALL: This is Calendar Number 38, Appeal Number 2007-

5   2444. Attorney is Mr. Michael Baniak.

6   JUDGE LORIN: Thank you. Good morning, Counsel.

7   MR. BANIAK: Good morning.

8   JUDGE LORIN: You're Mr. Michael Baniak, B A N I A K.

9   MR. BANIAK: That's right. That's my best, my best printing too.

10   JUDGE LORIN: Alright, Counsel, this is Appeal Number 2007-

11   2444. We have read your briefs and are familiar with the issues. You have

12   20 minutes when you're ready, you may proceed.

13   MR. BANIAK: Thank you. Michael Baniak on behalf of the

14   Applicants Alfred, DeMar et al. Let's talk about what the invention is.

15   JUDGE FETTING: Can you speak up a little bit?

16   MR. BANIAK: Yeah.

17   JUDGE FETTING: I'm having a little trouble hearing you.

18   MR. BANIAK: Let's talk about what the invention is and what the

19   prior art isn't. What we're dealing with here is a game, variously claimed as

20   a method, variously claimed as a gaming machine. And, it is based on a, a

21   fairly well known game called Keno. And, I don't know how many of you

22   get to casinos. I get there every now and then.

23   But, Keno is a game whereby you have a matrix with numbers on it

24   and the player selects various of those numbers. And, then the machine

25   proceeds to generate some random selection of its own numbers, and then

26   there's a match-up or not. And, depending on how many match up, based on

1   what the machine has selected then there's an outcome. Part of the

2   attraction to a user, to a player of Keno is there's this aspect of I have a

3   choice. I have a selection. I just don't clip a coin and pull a lever and then

4   things happen. I actually choose the spots where and choose the numbers

5   where I am, you know, at least having some input as to how the game is

6   progressing.

7   That's why Keno has its own place and why it's got own following.

8   There's also a game that we're all very familiar with that I just made

9   reference to which is a slot machine, whereby reels spin and then outcomes

10   are determined depending on how those reels may match up. This game is a

11   combination of spinning reels and Keno; hence the name Spin Keno.

12   What our client -- my client has done -- the Applicants have done is

13   put something together which has this element of selection associated with

14   it. And, allows the user now to pick spots according to what the user wants;

15   what the user's wager is. But, instead of those numbers matching up,

16   instead of the machine telling you how, you know, selection is going to be,

17   each one of those reels then spins, and it's a reel mechanism. In sense R E E

18   L. Those spin in each instance; every time to play the game. That's the

19   game play condition. And, then the outcome, the payout is determined on

20   how those elements match up. If you get three cherries, so located on the

21   board, then you win. Two cherries, no you don't win.

22   So, that's how this game, as claimed, and that -- and what I just

23   described is in all the claims. How this game is played and how this game is

24   claimed. What we don't have in the prior art, for example --

25   JUDGE LORIN: Counsel, let me stop you for a second.

26   MR. BANIAK: Sure.

1   JUDGE LORIN: I want to understand this game a little better that

2 you're inventing. You say it's not a Keno, but you -- the claim requires you

3 to select, select your spots, just like Keno, and then, and then other numbers

4 or other indicia are being randomly picked to compare with the one that's

5 been selected --

6   MR. BANIAK: No.

7   JUDGE LORIN: -- which Keno also does?

8   MR. BANIAK: No. What you end up with is you -- imagine you're

9 looking at a reel on a slot machine. Okay, the slot machine only has a

10 certain number of indicia that are going to show up; ten or whatever, you

11 know, plum, cherry, lemon, etcetera. Okay, the spots that you've selected in

12 the claimed game -- those spots, each one of those is going to choose from

13 that, that set of indicia and just that set of indicia. So --

14   JUDGE LORIN: If you, if you have a reel and you pick the cherry,

15 then the reel will move until something else comes up. If it comes up a

16 cherry, then it's, then you've matched it.

17   MR. BANIAK: Every time you go, every time you play this game,

18 as claimed, you end up with, you know, picking, you know, various spots

19 that you decide that's not -- I think that's my lucky one, that's my lucky

20 spot, and you pick those and then it is randomly going to generate. It's

21 going to spin and randomly generate something; a plum, a cherry, whatever.

22 And then, you look to see how those match up.

23   JUDGE LORIN: Oh --

24   MR. BANIAK: It's the matching relationship of those. So, it's the

25 randomness associated with the indicia that are being applied in each

26 instance. There's the difference between Keno because Keno you just pick,

1   you know, 45. You pick 30.

2   JUDGE LORIN: And, that indicia remains --

3   MR. BANIAK: That stays there.

4   JUDGE LORIN: -- while the other ones move and what you're

5   saying is your indicia actually moves as well.

6   MR. BANIAK: Every time, every time.

7   JUDGE LORIN: Okay.

8   MR. BANIAK: So, it's changed. So, there's the combination of a

9   spinning reel in a slot machine, and the Keno game. The Keno game, in

10   essence, just I have the ability to pick where these are, then I'm going to see

11   how things match-up afterwards. So, it's a very, it's a, it's a very different

12   game from Keno. It's a very different thing from a slot machine. So, we go

13   to, for example, take a look at Tarantino. The Examiner has given me a 102

14   rejection, anticipation on the basis of Tarantino.

15   We look at the Tarantino reference and just, for example, we go to,

16   you know, Claim 47. Just pick that one for purposes of a discussion today.

17   First we have a spinning reel. Look at Tarantino. Tarantino is a dice game

18   and the embodiment has specifically disclosed there, but let's move passed

19   the fact that, you know, we're dealing with a reel here. We look at the

20   limitations in my Claim 47 and I think that is strategic here when we

21   consider the Examiner's basis for his rejection. Look at the words. We've

22   chose these words very carefully, as a patent practitioner. I write these

23   words for the invention specifically. If I call it a reel, it's a reel. It's not

24   something else. If I say I have a control input, as in this claim, there's a

25   control input. Okay, very important language.

26   The user is exercising some control. I'm not dropping a coin in.

1   That's a separate element of the claim. The wager input. I put a wager in,

2   fine. Things may happen as a result of that wager, but I have a control input

3   that's separate from that wager input. Now, I register -- registering a

4   selection input by a player of selected reels. A very important strategic

5   limitation in these claims which is not anything you find in Tarantino. It's

6   not anything in the other reference, Simunek, on which Claim 47 is also

7   rejected as supposedly anticipated. Because I'm selecting, I'm selecting

8   particular reels in which to spin. I'm selecting less then all of the reels. I'm

9   not taking the entire board. I'm selecting less than all. Again, the user is --

10 the player is supplying input to the invention. That's the control input. That

11 word has meaning. Less than all the reels are selected. Then, after

12 registering that selection, and then the wager input, then I spin all of the

13 reels, okay. At least all of the selected reels. Maybe there are other ones

14 spinning, I don't care. My limitation is I, I at least spin all of the selected

15 reels; not just some. That's my game play condition, and then I have a pay

16 out as a result of that game play condition.

17   There's no control input in Tarantino. Nothing. The user just puts a

18 wager in, and that wager determines, for example, a column that's now

19 going to be activated.

20   JUDGE FISCHETTI: I guess I -- I'm trying -- I see where it says an

21 input mechanism through which your player provides a control and input,

22 but I don't see where the claim indicates what that control is over. I mean,

23 putting a coin in the slot certainly controls the, the, the subsequent

24 functioning of the game.

25   MR. BANIAK: Correct, go down to said operating system. The

26 control input is then tied into registering a selection input by a player of

1   selected reels. Control selection. Active verbs. The user is doing

2   something. The user is doing a selection. Whereas in Tarantino, there is no

3   such selection. All the user does is say I put one coin in, I get a column.

4   Now, if I succeed, because Tarantino is a building operation -- if I succeed

5   on that first coin, Tarantino says then put in another coin and now you can

6   advance and I'll give you two columns for that. No selection. I get two

7   more columns, and they're the next two columns. And, then if I succeed so

8   far I put another third coin and then maybe I get some more columns. It's a

9   building operation. It's a seriatim game. Very different from what we're

10   talking about in terms of these claims which are spun all at once based on

11   the selections that you've made.

12   So, it's not an anticipation, nor do you see that it's rendering our

13   claims in any way obvious as a result thereof. Not that there's an obvious

14   rejection on this particular claim based on Tarantino, but just look at the

15   invention and the context of, for example, of Simunek, the other supposedly

16   102 piece of prior art.

17   The Examiner has looked at Simunek and essentially said I see, I see

18   reels in that disclosure. I see reels that replace, replace selected items in a

19   Keno game, and so I see that I can take those reels and what I'm going to do

20   is, says the Examiner, is I'm going to interpret -- we have a creative

21   interpretation here, which I don't think is fair, of Simunek. And, what I'm

22   going to say is although Simunek tells us that those reels may appear and

23   those reels go in the place of matched indicia as in a standard Keno game,

24   I'm going to imagine a scenario where all of those particular elements, those

25   particular numbers that have matched -- I'm going to imagine all of those

26   happen to also match up with what the machine has generated.

1   So, in this particular, I would say magical situation, I picked ten spots,

2 alright. That's what I've done in Simunek. I've picked ten, and all ten

3 happen to match up. Now, I have reels replacing all of those ten, and then

4 those reels spin and a bonus scenario results. Alright, I don't think you can

5 do that. I don't think that is how that all works. I think you have to read the

6 disclosure for what it discloses, not what you imagine it might disclose.

7   You know, to me this is akin to that phrase where -- that, that analogy

8 where I had ten monkeys pounding on a typewriter for millions of years, I'm

9 going to get Romeo and Juliet. You can't do that with a disclosure such as

10 this. I think that's just what the Examiner is doing. Imagine a scenario like

11 that, then it would anticipate. It just doesn't work the same way. And, it

12 doesn't yield the game that's the same as our particular game because in

13 order to do what Simunek is talking about you have to have another step in

14 the process.

15   We have spinning reels. Each one spins every time. Now, in

16 Simunek that's not the situation. Because what happens in Simunek is you

17 have to pick those spots in the standard Keno game and the machine then

18 generates something, alright. And, as to those matches, Simunek says, in a

19 certain embodiment I'll replace some of those matches with reels, but the

20 machine is entered is, is a randomness associated with that. And, as I started

21 out here, the whole idea is that the user, the player, has that selective ability.

22 The user is going to say I want a reel there and I want to spin that reel and

23 something is going to happen with that reel. Not say -- not so with Simunek.

24 There's a random element generated in that, and that can be a massive

25 difference. A huge difference between a game that you want to play if you

26 go to a casino and a game that would be a total dog, because we don't see

1   any games such as what we see here Simunek out there. It's just not a game
2   that anybody would really want to play.
3   And, this is all about entertainment. It's all about getting users to play
4   the game because if they don't then there really is no point in creating a
5   game like this that nobody wants to play. The Examiner has essentially
6   treated Simunek, I think, as a nose of wax which many of us use that --
7   throw that term around in patent lexicon. But, that is a twisting a tourniquet
8   to try to make it into something that it really isn't. He's done the same thing
9   with Tarantino; taking that reference molding into something that it doesn't,
10 doesn't do. And, then on the obviousness aspect of the rejection as to those
11 certain claims, I don't see the Examiner putting these pieces together.
12 Somehow, someway in a manner that, you know, there's a teaching. There's
13 a motivation to do that. He basically just says this is a game. These are
14 games you can put them together, and there now I've got it. I've sort of
15 taken the game of monopoly and I've taken all those pieces and I've thrown
16 them into a box and now I take those pieces and I can put them together
17 somehow, someway and ignore the rules of each of those games, which are
18 entirely disparate.
19   The way that Tarantino was done and the way that Simunek is done;
20 very, very different games. They don't mesh and you can't take out of the
21 box and say, alright, I'm going to take those pieces and put them together
22 because I can find some or all of what's in your game and ignore the rules,
23 ignore what the teaching of Simunek is. Ignore what the teaching of
24 Tarantino is. And, then paste them together and say now I've got your game
25 because I can find those pieces in the art and ignore what the references
26 actually teach.

1   JUDGE LORIN: I have a question, a procedural one. I was going

2   through the record when I noticed the Examiner had applied a rejection of

3   Claims 37 to 38 and 44 to 46 under 103.

4   MR. BANIAK: Correct.

5   JUDGE LORIN: And, then when you filed the Appeal Brief, you

6   must have missed -- misunderstood and then responded to a rejection

7   involving Claims 25, 29, 39, 47 and 50.

8   MR. BANIAK: If you follow through the record here, sometimes

9   the, the rejections were not all that clear and all of the, you know, to me --

10   JUDGE LORIN: But these, but these rejections 37, 38, 44, 46, they

11 were in the final rejection.

12   MR. BANIAK: That's correct. Those are the only ones --

13   JUDGE LORIN: And, they were in the answer as well.

14   MR. BANIAK: Those were the only ones that the Examiner said

15 specifically a 103. What I did was, was I wanted to deal with the underlying

16 base claims in addition to that. So, I dealt with those on the off chance that's

17 what the Examiner also intended because we tried to talk to the Examiner on

18 an interview with the Examiner because I really felt that the Examiner was

19 totally missing, you know, not only our invention, but misinterpreting the

20 prior art, but I never got the opportunity. The Examiner did not want to have

21 an interview. So, I was perhaps reading more into that rejection on 103

22 basis, but there is no 103 basis beyond what you just articulated, Judge

23 Lorin.

24   JUDGE LORIN: Yeah, because I, I noticed then that in the Reply

25 Brief you present all these arguments that are on point with regard to those

26 claims.

10

1   MR. BANIAK: Correct.

2   JUDGE LORIN: Was there any response from the Examiner to those

3   arguments.

4   MR. BANIAK: No, because there was no additional brief that was

5   filed. The Examiner just said, you know, that's moot. And, I believe, what

6   he meant to say and said, you know, there's record of this. I believe what he

7   meant to say is was no record of any such 103 applied to the underlying

8   basis --

9   JUDGE LORIN: No, no that was in response to your, to your brief.

10   MR. BANIAK: Correct.

11   JUDGE LORIN: But, I'm asking whether there, there was any

12 response to your Reply Brief.

13   MR. BANIAK: No, Sir, not that I'm aware of. I didn't see anything

14 in the file. Nothing like that. So, you know, maybe I was exercising some

15 overkill in regard to arguing, you know, no obviousness rejection with

16 respect to the underlying claims let alone, you know, what's in the

17 dependent claims that the Examiner specifically rejected on 103 grounds.

18   JUDGE LORIN: But the limitations in those specific claims were

19 first argued in the Reply Brief.

20   MR. BANIAK: I don't believe so. I think we dealt with that in the

21 Opening Brief and the Examiner responded, you know, and then what I did

22 was discuss the underlying claims as not being obvious as well as not being

23 anticipated. Am I, am I answering the question or am I missing something?

24   JUDGE LORIN: No, I'm just reading, I was reading the record and I

25 noticed in the Reply Brief was the first time we see arguments with respect

26 to the specific limitations in the claims that were originally rejected.

1   MR. BANIAK: Right, I dealt with --

2   JUDGE LORIN: And, and I was simply asking whether the

3 Examiner ever responded to those arguments you had made.

4   MR. BANIAK: I don't think there's any served reply in there. The

5 Examiner basically said, you know, you're arguing obviousness --

6   JUDGE LORIN: Um-hum.

7   MR. BANIAK: -- and, I believe your argument is moot because I

8 never rejected on the basis of obviousness.

9   JUDGE LORIN: Well, no, the Examiner is saying that those weren't

10 the claims that were being rejected.

11   MR. BANIAK: Right, right. I'm sorry, you're correct. The

12 additional claims that I put in there were not rejected on the basis of

13 obviousness.

14   JUDGE LORIN: Right.

15   MR. BANIAK: Just those four dependent claims that you articulated.

16   JUDGE LORIN: Correct.

17   JUDGE LORIN: Any questions? Well, Counsel, there's no more

18 questions. Thank you, very much.

19   MR. BANIAK: Thank you.

20   JUDGE LORIN: And, we'll take your comments under advisement.

21   (Whereupon, the proceedings concluded.)